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| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | EXAMINER PARK, CHAN S | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,039

Applicant(s)

SUGIMOTO, TADAYUKI

Examiner

CHAN S. PARK

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 13-18, 25-30, 37-39 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 13-18, 25-30 and 37-39 is/are allowed.
- 6) ☒ Claim(s) 41-44 and 46-49 is/are rejected.
- 7) ☒ Claim(s) 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/29/09 has been entered.

Response to Amendment

2. Applicant's amendment was received on 1/29/09, and has been entered and made of record. Currently, **claims 1-6, 13-18, 25-30, 37-39 and 41-49** are pending.

Response to Arguments

3. Applicant's arguments, see page 12 of the Remark, filed 1/29/09, with respect to the rejections of claims 41-49 under 35 U.S.C. § 112, first paragraph, have been fully considered and are persuasive. The rejections have been withdrawn.
4. Applicant's arguments with respect to claims 41-49 have been considered but are moot in view of the new ground(s) of rejection.
5. The applicant states that "the printers disclosed in Murphy and Iwami do not use an electronic photography type process" (page 13 of the Remark). The examiner

respectfully disagrees. It should be noted that the original Specification does not provide any explanation/definition of what this "electronic photography type process" is. Therefore, the recited electronic photography type process, with the broadest reasonable interpretation, is construed as a type of an image process which is applied to an electronic photography image (e.g., digitally captured images).

The printer of Iwami certainly uses the electronic photography type image processing since it processes the digitally captured image data (JPEG image data) to print the image (Paragraph 45). At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printer of Murphy to include the image processor of Iwami. The suggestion/motivation for doing so would have been to provide a printer that can process and print the image data that have been digitally captured by a digital camera.

Note that the examiner construes "a page printer" as any printer that uses the electronic photography type process since the Specification does not provide any definition of the term.

Claim Objections

6. Claim 45 is objected to because of the following informalities:

Line 4, "said image forming device" should be -- said page printer --.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 41-44 and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. U.S. Patent No. 6,661,531 (hereinafter Murphy) in view of Iwami et al. U.S. Patent Application Publication No. 2004/0070672 (hereinafter Iwami).

With respect to claim 41, Murphy discloses an image forming device (printer 14 in fig. 1) for forming an image from image data transferred from a image data storage device (host computer 12 having a memory unit 18 in fig. 1) via an external interface (interface connecting the PC and the printer in fig. 1 & col. 4, line 50) that can be connected to said image data storage device, comprising:

a data size acquiring unit that acquires data size of said image data, for which an image is formed, from said image data storage device (data size sent by the PC in col. 4, lines 33-38 & lines 54-56); and

a calculating unit for calculating transfer completion time required for transferring said image data, for which said image is formed, based on said data size of the image data acquired by said data size acquiring unit (the amount of data to be received in col. 4, lines 54-56) and a speed of transferring data (estimate data rate in col. 4, lines 40-53) via said external interface (printer calculating the data transfer time in col. 4, lines 54-56).

Murphy, however, does not explicitly disclose that the image forming device is a page printer that uses an electronic photography type process, and the image data storage device is a portable image data storage device.

Iwami discloses a page printer that uses an electronic photography type process (paragraph 45) for directly receiving print data from a portable image data storage device such as a digital camera via external interfaces (fig. 5 & paragraph 51).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the image forming device of Murphy to receive the digitally captured image data from the digital camera and image process the image data as taught by Iwami.

The suggestion/motivation for doing so would have been to provide a direct communication between the printer and the digital camera for printing images without a host computer (paragraph 6 of Iwami).

Therefore, it would have been obvious to combine Murphy and Iwami to obtain the invention as specified in claim 41.

With respect to claim 42, Murphy discloses the image forming device further calculating: output completion time required for image forming output of the image data, for which said image is formed (calculating print process time in col. 5, lines 25-33).

With respect to claim 43, Murphy discloses the image forming device further comprising: an output setup information receiving unit for receiving output setup information to be set up concerning image forming output condition (unit for receiving user selection of quality settings in col. 5, lines 54-56).

With respect to claim 44, Murphy discloses the image forming device but it does not explicitly disclose a cancellation capability notifying unit for notifying that it is possible to cancel a connection with said image data storage device before the image forming output is completed for said image data, for which an image is formed, after the transfer is completed for said image data, for which an image is formed.

Iwami discloses a cancellation capability notifying unit for notifying that it is possible to cancel a connection with said image data storage device before the image forming output is completed for said image data, for which an image is formed, after the transfer is completed for said image data, for which an image is formed (unit for sending the JobDataDone command for notifying that all job data have been received to the digital camera in paragraph 61 & fig. 13). At the time of the invention, it would have been obvious to one of ordinary skill in the art that this command is a notification to the

digital camera that it is possible to cancel the connection between the two devices since it directly causes the digital camera to inform the user to disconnect the connection.

Furthermore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the image forming device of Murphy to include the cancellation capability notifying unit as taught by Iwami.

The suggestion/motivation for doing so would have been to inform the user before the completion of a print process of a digital image that the connection can be disconnected (paragraph 4 of Iwami).

Therefore, it would have been obvious to combine Murphy with Iwami to obtain the invention as specified in claim 44.

With respect to claims 46, Iwami discloses that said image data storage device is a digital camera (the printer connected to the digital camera in fig. 5).

With respect to claims 47, Murphy discloses that said image data storage device is a recording medium (memory unit 18 in host computer of fig. 1).

With respect to claim 48, Murphy discloses an image forming system (fig. 1), comprising:

a personal computer (host computer 12); and

an image forming device (printer 14) for forming an image from image data transferred from said PC via an external interface that can be connected to said PC (interface connecting the PC and the printer in fig. 1 & col. 4, line 50);

said PC including:

a transmitting unit for transmitting data size of image data, for which said image is formed, to said image forming device (PC sending the data size according to col. 4, lines 33-38 & lines 54-56);

said image forming device including:

a receiving unit for receiving the data size of the image data, for which said image is formed, from said PC (interface connecting the PC and the printer in fig. 1 & col. 4, line 50); and

a calculation unit for calculating transfer completion time required for transferring said image data, for which said image is formed, based on said data size of the image data received by said receiving unit (the amount of data to be received in col. 4, lines 54-56) and a speed of transferring data (the estimated data rate in col. 4, lines 40-53) via said external interface (printer calculating the data transfer time in col. 4, lines 54-56).

Murphy, however, does not explicitly disclose that the image forming device is a page printer that uses an electronic photography type process, and the image data storage device is a portable image data storage device.

Iwami discloses a page printer that uses an electronic photography type process (paragraph 45) for directly receiving print data from a portable image data storage device such as a digital camera via external interfaces (fig. 5 & paragraph 51).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the image forming device of Murphy to receive the digitally captured

image data from the digital camera and image process the image data as taught by Iwami.

The suggestion/motivation for doing so would have been to provide a direct communication between the printer and the digital camera for printing images without a host computer (paragraph 6 of Iwami).

Therefore, it would have been obvious to combine Murphy and Iwami to obtain the invention as specified in claim 48.

With respect to claim 49, arguments analogous to those presented for claim 41, are applicable.

Allowable Subject Matter

8. **Claims 1-6, 13-18, 25-30 and 37-39** are allowed.
9. **Claim 45** would be allowable if rewritten to overcome the claim objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625

February 23, 2009